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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/530,518 | 05/25/2000 | LYLE ARMSTRONG | 106141 | 2222 |

25944 7590 02/13/2003

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| EXAMINER |
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GITOMER, RALPH J

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| ART UNIT | PAPER NUMBER |
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1651

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/530,518

Applicant(s)
Armstrong et al.

Examiner
Ralph Gitomer

Art Unit
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 23, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-47 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

The amendment of 8/23/02 has been entered in view of the RCE request received 9/23/02. Claims 22-47 are currently pending in this application. No abstract is found in the file. Please
5 update the specification regarding related applications and priority.

All rejections of record are maintained.

10 Claims 22-47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

15 Amendments to the claims are new matter. In claim 22 and all occurrences, ~~XX~~X represents a group other than hydrogen that, as compared to where X is hydrogen~~XX~~ is new matter. In claim 47 ~~XX~~any group of hydrophobic type that, as compared to where X is hydrogen~~XX~~ is new matter. A negative limitation such as excluding
20 hydrogen requires a high degree of written description.

Regarding the rejections of record under 35 USC 102(b), applicants argue that none of the cited references teach the compound as claimed where X is now recited as not hydrogen. And none of the references teach the detection agent of claim 47 with a revealing agent.

It is the examiner's position that as broadly claimed, the claimed compounds are anticipated by each of the cited references. And a revealing agent could read on water where no particular function or structure is applied to such an agent.

Regarding the rejection of record under 35 USC 103(a), applicants argue Morris and Sellers do not teach the compound of claim 30. Claim 22 is not taught by Morris because p-nitrophenyl does not limit the diffusion in the medium of the keto acid produced.

It is the examiner's position that the groups taught by Morris may limit diffusion to some degree. As the compounds intended have not been clearly claimed, they are rendered obvious by Morris.

Claims 22-47 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the following applies in all occurrences.

There is inconsistency in the claims regarding what enzyme is intended. It would appear the claims are directed to deaminase but this is not claimed. As amended, the issues of record regarding what X may be are not resolved. The clause ~~XX~~ represents a group other than hydrogen that, as compared to where X is hydrogen~~XX~~ does not define what X may be. In claim 47 ~~XX~~any group of hydrophobic type that, as compared to where X is hydrogen~~XX~~ is unclear as to what X may be. Further, ~~XX~~a revealing agent~~XX~~ is not a term of art and is discussed on page 7 of the present specification. What is revealed by what is not seen as claimed. All issues under 35 USC 112, second paragraph, in the rejection of 4/23/02 are maintained for reasons of record.

The title of the invention is not aptly descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Serial No. 09/530,518
Art Unit 1651

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (703) 308-0732. The examiner can normally be reached on Tuesday-Friday from 8:00 am - 5:00 pm.

5 The examiner can also be reached on alternate Mondays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (703) 308-4743. The fax phone number for this Art Unit is (703) 308-4556. Any inquiry of a general nature or relating to the status

10 of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235. For 24 hour access to patent application information 7 days per week, or for filing applications electronically, please visit our website at www.uspto.gov and click on the button Patent Electronic Business

15 Center for more information.



Ralph Gitomer
Primary Examiner
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RALPH GITOMER
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